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28 STATE STREET
BOSTON, MA   02109

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·FEB 0 2 2005

OFFICE OF PETITIONS

In re Application of   :
Dinsmore   :
Application No. 10/790,636   : DECISION ON PETITION
Filed: 1 March, 2004   :
Attorney Docket No.: 56249-PHLL-157RE   :

This is a decision on the petition filed on 8 November, 2004 under 37 C.F.R. §1.47(b).

The petition is **DISMISSED**.

NOTES:

(1)   Any request for reconsideration of this decision <u>must</u> be submitted within TWO (2)
       MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R.
       §1.136(a) are permitted. The reconsideration request should include a cover letter
       entitled "Renewed Petition under 37 C.F.R. §1.47(b)."

(2)   <u>There will be no further reconsideration thereafter</u>.

BACKGROUND AND ANALYSIS

The record reflects that:

•   the instant application was received and given a filing date of 1 March, 2004, without,
     inter alia, a fully executed oath/declaration;

- the Office mailed a Notice of Missing Parts on 4 May, 2004, and Petitioner replied on 8 November, 2004, however, the Office mailed a Notice of Incomplete Reply on 16 November, 2004;

- Petitioner Mark G. Lappin (reg. No. 26,618) has filed, inter alia, a statement detailing the change in structure of the assignee, assignment documents, and the assent of the assignee to reissue, along with his statement of events to the effect that the non-signing inventor Mark Dinsmore (Mr. Dinsmore) was "offered" the application for review, however, the statement fails to demonstrate that the entire application in fact was transmitted to Mr. Dinsmore as required.

ANALYSIS

The commentary at MPEP §409.03(d) states:

* * *

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. (Emphasis supplied.)

Petitioner has failed to satisfy this burden with, for example, a copy of the transmittal letter forwarding to the non-signing inventor a copy of the entire application (description, claims, abstract, drawings) at the non-signing inventor's last known address–which address must demonstrate he has made a diligent effort to determine as current.

As of this writing, Petitioner has failed to satisfy the showing requirement of the regulation and the petition hereby is **dismissed**.

The renewed petition, if any, must be accompanied by the corroborating evidence required by 37 C.F.R. §1.47.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(703) 872-9306
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions